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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,760	03/11/2004	Marcus L. Thuesen	THUE:002	6421
39456	7590	10/05/2005		
KEITH B. WILLHELM, ATTORNEY AT LAW 6266 DEL MONTE HOUSTON, TX 77057			EXAMINER PICKETT, JOHN G	
			ART UNIT 3728	PAPER NUMBER
DATE MAILED: 10/05/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No. 10/798,760	Applicant(s) THUESEN ET AL.	
Examiner Gregory Pickett	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22-42 is/are pending in the application.
- 4a) Of the above claim(s) 8, 10, 27 and 30-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 11-20, 22-26, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 8, 10, 27 and 30-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/14/04 & 7/12/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election with traverse of Group I, Species 1 in the reply filed on 12 July 2005 is acknowledged. The traversal is on the ground(s) that the search would not have been burdensome. This is not found persuasive because it is well established that the searches between a product and process are divergent in nature.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1-4, 9, 11-20, 23-25, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baird et al (US 4,478,858; hereinafter Baird) in view of O'Connell (GB 2240758 A) and Planchard (FR 2422562 A; provided by applicant).

Claims 1, 28, and 29: Baird discloses packaging a product **20** a pouch container **15** with two pouched sections provided on substrate sheet **30** defining a sealed volume and accommodating product **20**. Baird is folded as claimed but lacks a removable advertising message section.

O'Connell discloses a bag **10** with removable advertising message **17** and message section **21 & 31** connected to a pouch section **22** and used to promote the sales of the items.

Planchard discloses a removable advertising message section **26**, which does not destroy the integrity of the sealed pouch.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Baird with a removable advertising message section as taught by O'Connell in order to promote the sales of the product.

It would have further been obvious to position the removable section above the seal of Baird as taught by Planchard in order to maintain the integrity of the sealed pouch.

O'Connell discloses distributing the packaged product to consumers in a consumer outlet.

Official Notice is taken that the packaging of a pouched product at one site with the subsequent distribution to a related consumer outlet (i.e. a grocery store) was known in the art at the time the invention was made. It is asserted that nearly every grocery store, at the time the invention was made, received some products distributed from off-site locations. It would have been obvious to one of ordinary skill in the art at

the time the invention was made to package the pouch of Baird-O'Connell-Planchard at one site with subsequent distribution to consumer outlets in order to maintain a single manufacturing plant able to serve a plurality of consumer outlets.

Applicant, of course, has the right to challenge this Official Notice in response to this decision and demand production of evidence in support thereof, provided such challenge is accompanied by adequate information or argument that, on its face, creates a reasonable doubt regarding the circumstances justifying the Official Notice. See In Re Boon, 439 F.2d 724, 169 USPQ 231, 234 (CCPA 1971).

Claims 2, 3, and 17: O'Connell discloses the provision of the product in a consumer outlet. Product 20 is a single-serve food product and its distribution to a food service establishment, such as a grocery store, would have been obvious.

Claims 4 and 22: O'Connell anticipates a message pertaining to a product of service other than the packaged product (see for example, page 3, lines 25-28).

Claim 9: O'Connell discloses tearing to separate the message section from the pouch section (see Figure 2).

Claims 11-16: the claimed sizes do not affect the claimed method in a manipulative sense. It has been held that to be entitled to weight in method claims, the recited structure limitations must affect the method in a manipulative sense, and not amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961). Further, the provision of the pouch in the sizes would amount to an obvious matter of design choice dependent upon the quantity of product to be provided.

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A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claim 18: Product **20** of Baird consists of granules.

Claims 19 and 20: Baird teaches that the pouch may be used to package other granular products. It would have been obvious to one of ordinary skill in the art at the time the invention was made to package sugar in the pouches of Baird-O'Connell-Planchard in order to complement the disclosed coffee.

Claim 23-25: O'Connell discloses a coupon with bar code. The specific type of bar code is deemed an obvious matter of design choice.

2. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baird-O'Connell-Planchard as applied to claims 1-3 above, and further in view of Chambers et al (US 2005/0086910 A1; hereinafter Chambers).

Baird-O'Connell-Planchard discloses the claimed method except for the packaging in a shipping carton with subsequent reading of an indicator.

Chambers discloses placing pouches **22** in a shipping carton **24** with a machine-readable indicator **60** for transport with subsequent reading upon receipt. As the indicator **60** is uniquely associated with the retained products, it is also considered to be uniquely associated with the advertising message. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the pouches of Baird-O'Connell-Planchard in a shipping carton as taught by Chambers in order to transport the pouches in bulk.

3. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baird-O'Connell-Planchard as applied to claim 1 above, and further in view of Hatakeyama (US 5,157,902).

Baird-O'Connell-Planchard discloses the claimed method except for the formation of the pouches from a continuous web.

Hatakeyama discloses a typical method for forming a pouch that takes a continuous web, folds it in half, seals on three sides, and subsequently cuts the pouches into individual units. It would have been obvious to one of ordinary skill in the art at the time the invention was made to produce pouches of Baird-O'Connell-Planchard using a continuous web as taught by Hatakeyama in order to mass produce the pouches.

Double Patenting

4. Applicant is advised that should claim 3 be found allowable, claim 17 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. Should claim 4 be found allowable, claim 22 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
30 September 2005


Mickey Yu
Supervisory Patent Examiner
Group 3700